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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,503	10/18/1999	CAMERON STUART BIRSE	004860.P2434	2896

7590 04/26/2005	EXAMINER
BLAKELY SOKOLOFF TAYLOR & ZAFMAN	VU, THONG H ·
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LOS ANGELES, CA 90025	

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| **Office Action Summary** | Application No. 09/420,503 | Applicant(s) BIRSE ET AL. |
| | Examiner Thong H. Vu | Art Unit 2142 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 20050420

1.   Claims 1-21 are pending.

2.   Claims 1-21 invokes the 112 sixth paragraph. Correction is required.

3.   Applicant's arguments filed 2/07/05 have been fully considered but they are not persuasive to overcome the Double Patenting Rejection. It was obvious that each system has an operating system with one or more volume as a design choice and the different operating system has been disclosed in '658 patent ['658, different configurations and architectures, col 8 lines 25].

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
     A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
     Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

     Claims 1-21 are rejected under the judicially created doctrine of double patenting over claims 1-11 of U. S. Patent No. 6,751,658 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

     The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('658) 10. A network computer (NC) server comprising:

a boot server means for providing a boot image to an NC client, the boot image including information identifying the location of one or more user system volumes on the NC server, so that the NC client can locally execute the boot image and mount the one or more system volumes, the one or more user system volumes containing operating system software;

a presentation means for presenting to the NC client, the one or more system volumes as a split operating system including a core operating system volume that can be read but not written by the NC client and the user operating system volume that can be read and/or written by the NC client, wherein the storage area associated with the NC client comprises the shadow volume corresponding to the user operating system volume, and wherein the NC client causing information identifying a modification associated with the attempt to be recorded comprises tracking modifications to the user operating system volume in the shadow volume; and

a storage management means for recording information identifying a modification to the operating system software in a shadow system volume associated with the NC client that is separate from the one or more user system volumes, the storage management means operative in response to a write request from the NC client that contains the modification.

(Application)

An apparatus comprising:

a NC server means comprising a first set of one or more system volumes means;

a NC client means for causing a plurality of NC clients means that are subsequently booted to receive operating system software that is configured differently than a first operating system in effect by replacing one (or more) system volume(s) means maintained at the NC server containing the first operating system software with a second set of one (or more) system volume(s) containing second operating system software operating system that is configured differently that currently in effect by replacing the one (or more) volume(s) with one (or more) different system volume means

It was obvious that each system has an operating system with one or more

volume as a design choice and the different operating system or different configurations

and architectures has been disclosed in '658 specification, col 8 lines 25.

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158

USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-21 are rejected under 35 U.S.C. § 102(e0 as being anticipated by

Murray et al [Murray, 6,3330,653 B1].

6.   As per claim 15, Murray discloses an apparatus comprising:

a NC server means comprising a first set of one or more system volumes means

[Murray, the server and one or more clients with different platform, col 10 lines 39-59];

a NC client means for causing a plurality of NC clients means that are

subsequently booted to receive operating system software that is configured differently

than a first operating system in effect by replacing one (or more) system volume(s)

means maintained at the NC server containing the first operating system software with a

second set of one (or more) system volume(s) containing second operating system

software operating system that is configured differently that currently in effect by

replacing the one (or more) volume(s) with one (or more) different system volume

means [Murray, another configuration, col 10 lines 39-59; replacing the partition or

volume, col 35 lines 16-30; subsequently booted, col 38 lines 31-46; creating a new

partition, the copy operation, col 41 lines 28-46].

7.   As per claims 4,7,9 Chase-Salerno discloses the NC client (i.e.: administrator on

control station) causing those of the plurality of NC clients that subsequently open an

application to utilize an altered version of the application by the replacing one or more

system volumes, wherein the one or more system volumes further comprises

application software as inherent of network software [Murray, software engine, col 11

lines 1-5 et seq.].

8.   As per claim 5, Chase-Salerno discloses wherein at least one NC client is not

rebooted for a period of time after replacing as a design choice.

9.   As per claims 6,8,10 Chase-Salerno discloses the operating software as

Macintosh, Windows95, Windows98, Windows NT, Windows 2000, Windows CE, AIX,

UNIX and Linux as inherent feature of operating software [Murray, Linux and

Windows95, col 10 lines 39-59].

10.   Claims 1-3,11-14,16-21 contain the similar limitations set for claim 15. Therefore

claims 1-3,11-14,16-21 are rejected for the same rationale set forth in claim 15.

        Any inquiry concerning this communication or earlier communications from the
examiner should be directed to examiner Thong Vu, whose telephone number is (571)-
272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-
4:30PM.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the
organization where this application or proceeding is assigned is 703-872-9306.
        Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval IPAIRI system. Status information for published
applications may be obtained from either Private PMR or Public PMR. Status
information for unpublished applications is available through Private PAIR only. For
more information about the PAIR system, see http://pair-direct.uspto.gov. Should you
have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142